

Attorney Docket No. 1418.04

PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: MANFREDI <i>et al.</i>	)	Group Art Unit: 1639
Serial No.: US 10/040,964	)	
Filed: January 4, 2002	)	
Title: METHOD OF DETECTING	)	Examiner: T. Wessendorf
PROTEIN-PROTEIN INTERACTIONS	)	

August 22, 2003

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT**

Sir:

In response to the Office Action dated July 23, 2003, in which a restriction requirement was set forth, Applicants elect, with traverse, Group I (claims 65-76) drawn to a method for detecting protein-protein interaction.

Applicants traverse the restriction requirement on the grounds that there is not a serious burden on the Examiner to examine the inventions divided into Groups I-IV. Here, a search for the use of inteins to detect protein-protein interaction is needed for all of Groups I-IV because all of the groups involve the use of inteins to detect protein-protein interaction. Therefore, it is not a serious burden to examine Groups II-IV when examining Group I because the same search is required for all groups. The MPEP §803 requires that an application **must be** examined on its merits even if it has independent or distinct inventions, as long as a serious burden is not put upon the examiner to search and examine the application. *See* MPEP, 8<sup>th</sup> Edition, August, 2001, page 800-4 (emphasis added). Accordingly, Applicants respectfully request withdrawal of the Restriction Requirement.

Applicants note that the inventions of Groups II and III are species of the invention of Group I and that there is no serious burden on the Examiner to examine a reasonable number of species claims. Specifically, the Restriction Requirement distinguishes Group

III from Groups I and II by characterizing Group III as requiring a “library”. However, the use of a “library” in Group III is simply a species of claims for using “fusion proteins” in Groups I and II. As required by MPEP §806.04(a) and CFR 1.141, a reasonable number of species may be claimed in one application if the claims to the species include all the limitations of the generic claim. *See* MPEP, 8<sup>th</sup> Edition, August, 2001, page 800-39. Here, all Group III claims include the limitations of a generic claim (Claim 66) in Group I because the use of a library of proteins is a species of the generic claim (Claim 66) of Group I for using a single protein. In particular, the use of a library expressing a plurality of proteins in all Group III claims is a specific embodiment of the generic claim (Claim 66) of Group I for expressing a single protein. Similarly, the Restriction Requirement distinguishes Group II from Group I by characterizing Group II as requiring “transmembrane fusion.” However, “transmembrane fusion” in Group II is a specific species of the Group I claims (Claims 67-76) involving “anchoring to a cell membrane.” Thus, all Group II claims include the limitations of a generic claim in Group I. Furthermore, the claims in Groups II and III are a reasonable number of claims so that no serious burden is put upon the Examiner to examine Groups I-III together. Therefore, Applicants respectfully request that Groups I-III be examined together.

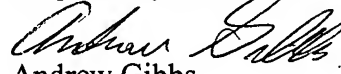
Applicants also note that Group IV, drawn to a kit, can not be used to practice a process that is materially different from the methods of Groups I-III and that the methods of Groups I-III can not be practiced with a product that is materially different from the kit of Group IV. In order to restrict a product and process of using the product the MPEP §806.05(h) requires the Examiner to provide an example showing: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process. *See* MPEP, 8<sup>th</sup> Edition, August, 2001, page 800-46. The present Restriction Requirement does not provide such an example for restricting the product of Group IV from the methods of Groups I-III. In particular, the Restriction Requirement does not provide an example showing how the vectors and instructions of Group IV claims can be used for any process that is materially different from detecting protein-protein interaction with inteins according to the methods of Groups I-III. Consequently the present Restriction Requirement does not meet the

burden imposed by the MPEP §806.05(h) and Applicants respectfully request that the Restriction Requirement be withdrawn and that Groups I-IV be examined together.

In view of the above remarks, Applicants respectfully request that Groups I-IV be examined together on the merits. Reconsideration of the restriction requirements in view of the above remarks is earnestly requested.

It is not believed that any extension of time, or any fee is required in connection with this communication. However, if an extension of time (and extension fee) or other fees are required, such an extension of time is hereby petitioned for and the Commissioner is authorized to charge any fees or credit any overpayment to Deposit Account No. 50-1627.

Respectfully submitted,



Andrew Gibbs

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Michael Moreno

8.22-03  
Date